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EXAMINER

NGUYEN, TAN D

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/027,658	Applicant(s) SHUMPERT, JAMES MICHAEL	
	Examiner Tan Dean D. Nguyen	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application:
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) 7, 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Status

Claims 1-18 are pending and rejected as followed.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling.** The step of "notifying the user of the results of the request" is critical or essential to the practice of the invention, determination of an issue in response to a request of a user to resolve the issue, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). From page 2, line 31 of the specification, under "Summary of the invention" as well as Fig. 3, item (70), it shows the essential steps of the claimed invention are 4 steps "The steps of providing the identity, matching, processing and notifying". To response to a user's request for a result, it's conventional that the result of the request be notified to the user to complete the request/response cycle. Therefore, the inclusion of the notifying step, as shown in dep. claim 2 or 11, into the independent claim is requested in order to overcome this rejection.

Art Unit: 3629

3. Claims 1-9 (method), 10-18 (system) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As of 1/20/2006, claims 1-2 are as followed:

1. A computer-implemented method for determining authenticity of a business partner in response to a request of a user comprising:

- (a) receiving a request of a user to determine authenticity of a business partner;
- (b) receiving an identity of said business partner from said user;

(c) matching said identity of said business partner to a business data record of a business that is one of a plurality of businesses by searching at least one database for said business data record having attributes that match said identity, wherein said data record includes at least one data attribute; and

(d) processing one or more of said at least one data attribute of said matched data record according to a set of authentication rules to determine if said business partner is authentic, wherein said at least one data attribute represents at least one credential of said business partner.

2. The method of claim 1, further comprising: notifying said user of the results of said matching performed in step (c), and wherein said notifying step and steps (a), (b) and (c) are automatically performed by a computer system either alone or in combination with a user device via a network.

1) In claim 1, step (c), the last phrase, "wherein said data record includes at least one data attribute" appears to be redundant and is vague. The previous phrase

Art Unit: 3629

"... business data record having attributes" shows that the record has a number of attributes, so it's not clear the purpose of repeating this phrase again and now limits it to just "at least one data attribute"?

2) In claim 1, step (d) , the last phrase "wherein said at least one data attribute represents at least one credential of said business partner" is vague and indefinite because it's not clear whether this phrase refers to the "data attribute" of step (c) "matching" or (d) "determining" or both? Clarification is required.

3) Claim 2 calls for the notifying of the user the results of the matching performed in step (c) of independent method claim 1 above. This is confusing since the final results should come from the final step of "determining if the business partner is authentic" and not mere "matching" unless step (d) is not critical. However, as indicated in the preamble of the claim which calls for "method for determining authenticity of a business partner in response to a request of a user", it makes no sense to notify the result of the matching step and not the final step so that the result is more accurate. Correction is required.

4) Claim 2 calls for the carrying out of steps of (a)-(c) of claim 1 "automatically performed by a computer system". What happens to step (d)? Is step (d) carried out manually then? How could this be? Mixing both "manually" and "automatically in the same invention?

5) Similarly, independent system claims 11-12, which have similar limitations as in claims 1-2, are rejected for the same reasons set forth in the rejections of claims 1-2 above.

6) Dependent claims 7 and 16 are vague since it's not clear if step (c) fails to find a match, then is there a step (d), since step (d) depends on the previous matching of step (c)?

7) Dependent claim 8 and 17 are vague since the "at least one data attribute of said matched data record already represents at least one credential of said business partner" as shown in step (d) of claim 1 or 11, it's not clear why one has to search it again for something that has been found?

Claim Objections

4. Claims 7 and 16 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The independent calls for carrying out steps (a)-(d). Claim 7 or 15 calls for step (c) to be not working which is improper.

Claim Rejections - 35 USC § 103

5. Claims 1-10, 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Applicant's Admitted Prior Art (AAPA) in view of (2) GUSTAFSON and (3) CALVER.

As of 1/20/2006, claim 1 as followed:

1. A computer-implemented method for determining authenticity of a business partner in response to a request of a user comprising:

(a) receiving a request of a user to determine authenticity of a business partner;

Art Unit: 3629

(b) receiving an identity of said business partner from said user;

(c) matching said identity of said business partner to a business data record of a business that is one of a plurality of businesses by searching at least one database for said business data record having attributes that match said identity, wherein said data record includes at least one data attribute; and

(d) processing one or more of said at least one data attribute of said matched data record according to a set of authentication rules to determine if said business partner is authentic, wherein said at least one data attribute represents at least one credential of said business partner.

AAPA, as cited on page 1, line 8 to page 2, line 14, fairly teaches current method for determining authenticity of a business partner in response to a request of a user in an off-line or manual technique {see page 1, lines 30-31 "*Current methods Use an off-line technique...*"}. **AAPA** fairly teaches the claimed invention except for carrying out using a computer or "computer-implemented" and carrying out step (d) according to a set of authentication rules.

GUSTAFSON, which is US patent No. 6,569,731 as cited by applicant in the specification page 2, lines 8-9, discloses the use of authentication rules (scores and rating using a variety of algorithms), as part of the current method for authenticating a business partner, to increase the confidence or precision or accuracy of the data match, the higher the score/rating, the closer the match {see col. 6, lines 25-55}. It would have been obvious to modify the teachings of **AAPA** to include the authentication rules as taught by **GUSTAFSON** for the benefit of increasing the confidence or precision or

Art Unit: 3629

accuracy of the data match, the higher the score/rating. Note that the term “a set of authenticating rules” is broad and could include other well known/conventional rules to improve the accuracy of the match, unless specified in the claim. There is no specification of the types of “authentication rules” in claim 1.

Note also on col. 4, lines 45-48, GUSTAFSON also discusses the use of other “authentication attributes” such as state of incorporation, approximate number of employees, manufacturing or service organization codes, and the like, etc. Therefore, it would have been obvious to a skilled artisan to use other authenticating attributes (or rules) to improve the matching accuracy if needed.

AAPA /GUSTAFSON fairly teaches the claimed invention except for carry the steps on a computer or “computer-implemented”.

In a similar method for providing interactive communication in response to a request of a user with respect to business information request, **CALVER** cites the carrying out the communication by providing solution (result information) in response to a request of a user on a computer and/or automatically and on the Internet or web site to significantly lower the cost of service than providing the same solution via a phone call or manually {see Fig. 3, [0058], [0021], [0014]}. It would have been obvious to modify the teachings of AAPA /GUSTAFSON by carrying the communication in response to a request of a user on the computer/Internet/web as taught by CALVER for the benefit of to significantly lower the cost of service than providing the same solution via a phone call or manually {see [0058]}. As for the difference in the types of “data processing” or communication responses between AAPA /GUSTAFSON and CALVER,

Art Unit: 3629

this is not critical since they all deal with "data processing" in general and the application of any types of data processing or data analysis or communication whether they are business related or not would have been obvious to a skilled artisan. Moreover, the types of data, identity data, data attributes or data credentials are normally considered "non-functional" descriptive material and carry no-patentable weight. The essential parts are the providing business information (solution) or notifying the solution to a user in response to the user's request for a solution such as "determining authenticity of a business partner". The use of any other types of business request would have been obvious in view of the teachings of CALVER in general.

Note also that CALVER also teaches the use of "business rules" in carrying out the analysis of the user request to obtain the appropriate response {see Fig. 13, [0127]-[0129]}, so it would have been obvious to modify the teachings of AAPA /GUSTAFSON to include the use of business rules as taught by CALVER if desired.

As for dep. claim 2 (part of 1 above) which deals with notifying the result to the user and further carrying out the steps (a)-(c) automatically by a computer system, this is taught in CALVER {see Fig. 16, "Web site", and [0021] for "automatically"}. Note that the automation step is well known step and is taught in GUSTAFSON col. 2, lines 50-55, or would have been obvious to a skilled artisan to do so to improve efficiency. See *In re Venner*, 120 USPQ 192, CCPA 1958.

As for dep. claims 3-5 (part of 1 above) which deals with well known computer data entry parameters, i.e. standard template for entry of data or filling out a form, this is taught in CALVER in [0052], [0061], Fig. 3 and Fig. 16.

As for dep. claim 6 (part of 1 above) which deals with well known authentication rules parameter, i.e. types of rules such as current transactions with trade reference, etc., this is fairly taught in GUSTAFSON col. 4, lines 45-50 as "other attributes for matching/determining authenticity such as state of incorporation, approximate number of employees, manufacturing or service organization codes, and the like, etc. and therefore, the use of any other similar type of business identification would have been obvious to a skilled artisan as mere using other well known similar business identification to achieve similar results. Moreover, this varies with the type of request, business entity, etc., and the selection of the desired information is within the knowledge of the skilled artisan, an experienced businessperson with many years of practical experience. Moreover, this is non-functional descriptive material (information) and generally receives no patentable weight unless there is a step for carrying out a transaction.

As for dep. claim 7 (part of 1 above) which calls for the step of presenting a registration template, this is taught in CALVER [0060]-[0063].

As for dep. claims 8-9 (part of 1 above) which deals with well known matching parameters, i.e. other attributes such as license, professional membership, etc., these are fairly taught in GUSTAFSON col. 4, lines 45-50 as "other attributes for matching/determining authenticity such as state of incorporation, approximate number of employees, manufacturing or service organization codes, and the like, etc. and therefore, the use of any other similar type of business identification would have been obvious to a skilled artisan as mere using other well known similar business

Art Unit: 3629

identification to achieve similar results. Moreover, this varies with the type of request, business entity, etc., and the selection of the desired information is within the knowledge of the skilled artisan, an experienced businessperson with many years of practical experience. Moreover, this is non-functional descriptive material (information) and generally receives no patentable weight unless there is a step for carrying out a transaction.

As for independent system claims 10-18, which are merely the system to carry out the method claims 1-9 as cited above, they are rejected over the system/element to carry out each respective step of independent claim 1 and dep. claims 11-18 as rejected above. Alternatively, the set up of a respective system to carry out the same method claim as shown in claim 1 would have been obvious to a skilled artisan. Figs. 3, 4, 5 and 16 of CALVER is a typical computer system for carrying out the method steps as shown in steps (a)-(d) above.

Response to Arguments

6. Applicant's arguments, see paper filed 3/15/07, with respect to the rejections of claims 1-18 have been fully considered and are persuasive. The rejections of claims 1-18 have been withdrawn.
7. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection as cited above.
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 2002/0091945, by Ross, teaches verification engine for user Authentication with various authentication rules, etc. teaches similar limitations as in the claimed invention and is cited here for applicant's awareness of potential use in the future if needed.

No claims are allowed.

Art Unit: 3629

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are **(571) 273-8300**. My personal Fax is **(571) 273-6806**. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
May 28, 2007



DEAN T. NGUYEN
PRIMARY EXAMINER